

REMARKS/ARGUMENTS

The amendments set out above and the following remarks are believed responsive to the points raised by the Office Action dated January 13, 2009. In view of the following remarks, reconsideration is respectfully requested.

The Pending Claims

Claims 1-13 remain pending, wherein claims 10 and 11 have been withdrawn from consideration.

*THE OFFICE ACTION**Objection to the Restriction Requirement, as well as to the Finality of the Restriction Requirement*

While the Office Action indicates that “the restriction requirement has been made reconsidered, deemed proper, and made final for reasons of record,” the Office Action did not fully address Applicants’ remarks, and the Office Action renders unclear what the basis for the restriction requirement is.

In setting out the restriction requirement (dated August 22, 2008), the Examiner stated that, under PCT Rule 13.2, the inventions listed as Groups I and II lacked the same or corresponding special technical features because “[c]laim 6 is either obvious or anticipated by Hatch (WO 97/32207).”

Applicants responded by explaining why claims 1 and 6 are novel and unobvious.

However, the present Office Action did not address this argument.

The present Office Action refers, on page 2, to “an obvious inadvertent typographical error” in that “[c]laim 6’ should read ‘claim 10,’” but provides no further explanation. The remark in the Office Action is not tied into any particular argument or response. If this is intended to correct a misstatement in the previous restriction requirement, the exact basis for the restriction should be clearly stated, and Applicants should be given an opportunity to respond to the new restriction requirement. Moreover, if this is intended to correct a

misstatement in the previous restriction requirement, Applicants do not agree it was “an *obvious*” typographical error (emphasis added).

Hatch (WO 97/32207) merely describes a collapsible column for compressing packing material by liquid chromatography columns and methods of use. Pending independent claims 1 and 10 encompass, respectively, “separating the second end of the column tube and the second end cell structure to provide an access spacing between them, advancing the piston portion of the first end cell structure through the column tube to expose it at the open second end of the column tube, and carrying out maintenance of the piston portion thus exposed” (claim 1), and a column tube having first and second ends, and first and second discrete end cell structures which are associated with the respective ends of the column tube, “wherein the first end cell structure has an insertable support structure which supports the piston portion from behind, connects beyond the first end of the column tube to a drive means for controllably moving the column tube and piston portion axially relative to one another, and has sufficient axial reach for the piston portion to be exposed at the open second end of the column tube as aforesaid while still supported by the insertable support structure” (claim 10). Thus, claims 1 and 10 share corresponding special technical features, and are novel and unobvious.

Accordingly, Applicants respectfully request withdrawal of the restriction requirement. Moreover, if the restriction requirement is to be maintained, Applicants respectfully request that the requirement be clearly set out, so that Applicants can respond.

Rejection under 35 USC 103(a)

Claims 1-9 and 12-13 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent 5,167,809 to Mann (hereinafter referred to as “Mann ‘809”) in view of U.S. Patent 6,736,974 to Mann (hereinafter referred to as “Mann ‘974”).

This rejection is respectfully traversed.

For subject matter defined by a claim to be considered obvious, the Office must demonstrate that the differences between the claimed subject matter and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

35 USC 103(a); see also *Graham v. John Deere Co.*, 383 US 1, 148 USPQ 459 (1996). The ultimate determination of whether an invention is or is not obvious is based on certain factual inquiries including: (1) the scope and content of the prior art, (2) the level of ordinary skill in the prior art, (3) the differences between the claimed invention and the prior art, and (4) objective evidence of nonobviousness. *Graham*, 383 US at 17-18, 148 USPQ at 467.

For purposes of the analysis here, and for the sake of argument, the level of ordinary skill in the art can be considered to be relatively high, such that a person of ordinary skill in the art would have an advanced degree and/or several years of experience in the relevant field.

Consideration of the aforementioned *Graham* factors here indicates that the present invention, as defined by the pending claims, is unobvious in view of the cited references.

Regarding the scope and content of the prior art, and the differences between the claimed invention and the prior art, Mann '809 teaches a chromatography system including at least one container having a neck formation adapted to engage end flanges of a column to allow discharge of separation media from the column into the container upon unpacking, and from such a container into the column upon re-packing (col. 1, lines 41-50). Mann '809 makes clear that after the piston **11** is advanced from the top end of the column tube **7** toward the bottom end, the bottom end remains engaged to the neck collar **24** of the container **20**, via clamp **21** (col. 3, line 65 through col. 4, line 8 (*see also*, Fig. 3)). There is no suggestion that the advanced piston can be exposed at the open bottom end of the tube; rather, Mann '809 expressly teaches that "piston **11** will have to be retracted before the container **20** can be removed" (col. 4, lines 5-6).

Mann '974 also fails to teach or suggest advancing a piston from the top end of a column tube toward the bottom end such that the advanced piston is exposed at the open bottom end. Rather, Mann '974 teaches raising the plunger **20** from a top **54** of the cavity **22** within the cylinder **12** (col. 4, lines 52-54; Fig. 4). After maintenance, the plunger **20** is lowered, but is never advanced such that it is exposed at the open bottom end of the cylinder **12** such that maintenance of the exposed plunger is carried out (*see, for example*, Fig. 5 and col. 5, lines 12-20).

There is no suggestion in Mann '809 and Mann '974 of advancing a piston from a first end of a column tube toward a second end to allow it to be exposed at the open bottom end of the cylinder such that maintenance of the exposed piston portion is carried out, and there is no explanation in the Office Action as to why such a specified modification would have been obvious to one of skill in the art.

Moreover, there is no suggestion in the cited references of advantages that can be provided by embodiments of the invention, e.g., providing access positions for the first and second ends of the column tubes that are relatively close to one another and/or greatly reducing the potential access height requirement (*see, for example*, the present application, page 10, lines 18-24).

For purposes of the analysis here, there is no need to consider any objective criteria of nonobviousness.

Considering all of the *Graham* factors together, it is clear that the present invention would not have been obvious to one of ordinary skill in the art at the relevant time in view of the combined disclosures of Mann '809 and Mann '974. Accordingly, the obviousness rejection should be withdrawn.

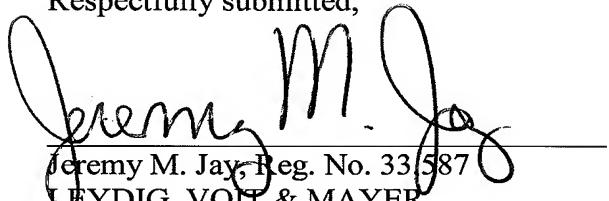
Since independent claims 1 and 10 are allowable for the reasons set forth above, the dependent claims are allowable as they depend from the novel and non-obvious independent claims.

For the reasons set forth above, reconsideration of the rejection is respectfully requested.

Conclusion

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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